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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/737,211

12/16/2003

Andreas Junghans

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12/06/2006

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/737,211

Applicant(s)

JUNGHANS ET AL.

Examiner

Anish Desai

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the appeal brief filed on 09/25/06 and the reference of Horiki et al. (US 4,868,045), PROSECUTION IS HEREBY REOPENED. The new grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

1. All of the art rejections are maintained. Further a new anticipation type rejection is made in view of Horiki et al. (US 4,868,045).

2. The obviousness type double patenting rejections over a copending Application No. 10/739,705 are moot because said copending application is abandoned.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Horiki et al. (US 5,897,949).

In this Office action, the preamble limitation of “for single-sided or double-sided adhesive sheet strips...of the bond” is not given any patentable weight because said preamble limitation is an intended use of the claimed pressure sensitive adhesive. Thus the claim 1 is interpreted as a pressure sensitive adhesive comprising a mixture of at least one block copolymer, at least one tackifier, and at least one water-soluble polymer.

Horiki teaches a masking member comprising a base and an adhesive layer has been provided to protect a surface of an article from a surface treatment (column 1, lines 22-24). Regarding claim 1, the adhesive of Horiki comprises a water-soluble polymer (column 1, lines 59-61), adhesive such as styrene-butadiene block copolymer latex (column 2, lines 19-20), and stickifier (tackifier) such as rosin derivative (column 2, lines 49-51).

With respect to claims 2 and 3, Horiki teaches that the amount of water-soluble polymer is from 0.1 to about 20% by weight of the weight of said emulsion-type adhesive (column 1, lines 60-61). Regarding claim 4, Horiki discloses water-soluble

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polymers such as polyacrylamide (column 2, line 66). With respect to claim 5, Horiki teaches that plasticizers can be included in the adhesive (column 2, line 42). Regarding claim 6, Horiki teaches calcium carbonate as a filter (filler) (column 2, lines 57-59). With respect to claim 7, Horiki discloses a masking member with adhesive composition of claim 1 as disclosed above. The masking member of Horiki reads on a single sided adhesive sheet strip as claimed in claim 7. Accordingly Horiki anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luhmann et al. (US Patent 5,897,949) in view of Horiki et al. (US 4,868,045).

Luhmann teaches an adhesive tape which can be redetached by pulling, without residue and without damage, having a foam backing coated on one or the both sides with a self-adhesive composition (see Abstract). The self-adhesive tape of Luhmann can be used in labels, signs, for joining materials which are to be parted at later point in time, sealing elements etc. (Column 3, lines 45-58). Moreover, the self-adhesive tape of Luhmann contains block copolymers (Column 3, lines 60-61) and tackifiers (Column 4, line 16). Regarding the claims 5 and 6, the pressure sensitive adhesive of Luhmann

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contains plasticizers, light stabilizers, antioxidants, and fillers such as silica, glass, alumina, zinc oxides, calcium carbonate, titanium dioxides, and carbon black (Column 4, lines 31-39).

Luhmann is silent as to teaching of a water-soluble polymer in a pressure sensitive adhesive (claim 1), amount of water-soluble polymer (claims 2 and 3), types of water-soluble polymers (claim 4), an additive as claimed in claim 5, and filler as claimed in claim 6. The invention of Horiki is previously disclosed. Additionally, Horiki teaches that addition of prior art release agents in the adhesive layer may bring about a deterioration of stickiness, weatherability, heat resistance and the like (column 1, lines 39-42). According to Horiki, the water-soluble polymer [of his invention] in emulsion type adhesive may increase the cohesive force of the adhesive and at the same time give the adhesive a releasing property (column 1, lines 62-65). Since the water-soluble polymer of [Horiki's invention] does not soften even at high temperature, the cohesive force of the adhesive does not decrease in high temperature, and the water-soluble polymer does not deteriorate stickiness and weatherability of the adhesive (column 1, lines 62-68, column 2, lines 1-2). Thus, **compare** to the prior art release agents the water-soluble polymer (release agent) of Horiki provides **improvement** in weatherability and stickiness of the adhesive. Additionally, note that the water soluble polymer of Horiki is shown to be compatible with the adhesives comprising block copolymers such as styrene-butadiene block copolymer and stickifier (tackifier) such as rosin and rosin derivatives (column 2, line 19 and column 2, line 49). The primary reference of Luhmann is also disclosing pressure sensitive adhesive composition comprising

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styrene-butadiene block copolymers (column 3, line 63, column 4, lines 1-4) and tackifier such as rosin and its derivatives (column 4, line 16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the water-soluble polymer of Horiki in the amount disclosed by Horiki in the pressure-sensitive adhesive of Luhmann, motivated by the desire to improve the cohesive force of the pressure-sensitive adhesive of Luhmann without deteriorating the stickiness of the pressure-sensitive adhesive.

Response to Arguments

5. Applicant's arguments (Appeal Brief) filed 09/25/06 have been fully considered but they are not persuasive.

103-type rejections of Luhmann in view of Horiki are maintained for the following reasons.

The applicant argues that contrary to the examiner's motivation as set forth in the Final Office action dated 03/08/06 and Advisory action dated 07/07/06, the secondary reference of Horiki does not teach or suggests anything about **improving** the weatherability or heat resistance of the adhesive but rather avoiding the deterioration of weatherability and heat resistance (see pages 4 and 7 of the Appeal Brief). The examiner respectfully disagrees. Horiki teaches that addition of prior art release agents in the adhesive layer may bring about a deterioration of stickiness, weatherability, heat resistance and the like (column 1, lines 39-42). As previously noted, according to Horiki the water-soluble polymer [of his invention] in emulsion type adhesive may increase the cohesive force of the adhesive and at the same time give the adhesive a releasing

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property (column 1, lines 62-65). Since the water-soluble polymer of [Horiki's invention] does not soften even at high temperature, the cohesive force of the adhesive does not decrease in high temperature, and the water-soluble polymer does not deteriorate stickiness and weatherability of the adhesive (column 1, lines 62-68, column 2, lines 1-2). Thus, **compare** to the prior art release agents the water-soluble polymer (release agent) of Horiki indeed provides **improvement** in weatherability and stickiness of the adhesive. Additionally as previously noted, the water-soluble polymer of Horiki is shown to be compatible with the adhesives comprising block copolymers such as styrene-butadiene block copolymer and stickifier (tackifier) such as rosin and rosin derivatives (column 2, line 19 and column 2, line 49). The primary reference of Luhmann is also disclosing pressure sensitive adhesive composition comprising styrene-butadiene block copolymers (column 3, line 63, column 4, lines 1-4) and tackifier such as rosin and its derivatives (column 4, line 16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the water soluble polymer of Horiki in the adhesive of Luhmann, motivated by the desire to improve the cohesive force and weatherability of the adhesive.

The applicant argues that the masking tape of Horiki is not a stretchable tape and the water-soluble polymer of Horiki is not taught as being stretchable and is not taught as being residueless (page 6 of the Appeal Brief). The applicant's arguments are not found persuasive in determination of patentability because said arguments are irrelevant to the basis of the rejection because the primary reference of Luhmann

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already discloses redetachable adhesive tape that can be redetached from a substrate without residue (see abstract of Luhmann).

The applicant argues that it is more likely that addition of the water-soluble polymer of Luhmann may be detrimental to Luhmann's adhesive because it would absorb water and deteriorate the adhesive. The applicant's arguments are not found persuasive in determination of patentability because said arguments are based on applicant's personal opinion and not based on any factual evidence on the record (MPEP 2145).

The applicant argues that the adhesive tape of Luhmann has a powerful bond to the substrate which can be broken by stretching the tape. Thus, according to the applicant, the addition of releasing property (i.e. water soluble polymer of Horiki) would be detrimental to high bond strength that is intended for the tape of Luhmann. Therefore, there is no need to add water-soluble polymer (release agent) of Horiki to the adhesive of Luhmann because the cohesion is already high in the adhesive of Luhmann (because tape can be removed without leaving any residue) (pages 7 and 8 of the Appeal Brief). The examiner recognizes that the tape of Luhmann has high bond strength but yet it can be released from a substrate without leaving any residue on the substrate. However, there is no teaching or suggestion in the secondary reference of Horiki that would indicate that the water-soluble polymer of his invention would reduce the bond strength. In fact, as previously noted, compare to the prior art release agents, Horiki teaches that the water-soluble polymer (release agent) of his invention will not reduce the stickiness (bond strength) of the adhesive (column 1 lines 65-68 and column

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2 lines 1-2). Horiki also teaches that a further object of his invention is to provide the adhesive layer having a suitable stickiness (column 1, lines 48-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the water-soluble polymer of Horiki in the amount disclosed by Horiki in the pressure-sensitive adhesive of Luhmann, motivated by the desire to improve the cohesive force of the pressure-sensitive adhesive of Luhmann without deteriorating the stickiness of the pressure-sensitive adhesive. Accordingly, art rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD



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